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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,902	04/09/2004	Peter Leonard Hutchison	4046/019	2437
23440 7590 03/21/2008 GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 10016-0601				
EXAMINER				
TOOMER, CEPHIA D				
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1797				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/821,902

**Applicant(s)**

HUTCHISON, PETER LEONARD

**Examiner**

Cephia D. Toomer

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 7-20 is/are rejected.
- 7) ☐ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is in response to the amendment filed December 19, 2007 in which claims 1, 19 and 20 were amended and claim 21 was added.

#### ***Election/Restrictions***

1. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims are directed to a flue cleaner classified in class 44, whereas claim 21 is directed to a method of cleaning a flue or chimney which is classified in class 134.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

If the composition is made up of the sawdust and binding agent, it is not clear how the composition (sawdust and binding agent) controls and restricts the combustion of the sawdust when the flue cleaner is placed in a fire.

The rejection is maintained because the claim as written is confusing. Applicant's explanation is that the sawdust/binder composition controls and restricts the formation of the vapors by controlling the combustion of the agent. The claim as written does not set forth such limitations. There is no mention of the sawdust/binder composition controlling the combustion of the soot removal agent.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 8, 11, and 18-20 rejected under 35 U.S.C. 102(b) as being anticipated by Owens (US 6,129,774).

Owens teaches a clean airflow catalyst comprising a container made of aluminum wherein the container defines a flow path through which the fuel flows. The container holds a plurality of pellets or bullets made of lead, tin, antimony, zinc and nickel (see abstract; col. 2, lines 14-15, 36-39). Owens teaches that the container comprises a hollow metal cylindrical wall having an internal cavity defining a flow path. The wall has internal threads and at opposite ends to which two identical caps are screwed. Each of the caps comprises a head with an opening formed there through and a cylindrical cap wall with threads to be screwed to the threads of the cylindrical

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member. At each cap is a screen inwardly secured, and between the screens is the plurality of the pellets or bullets (see Fig 1 and col. 2, lines 14-28).

It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Accordingly, Owen teaching all the material limitations of the claims anticipates the claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 9, 10 and 12-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (US 6,129,774).

Owens has been discussed above. Owens teaches the limitations of the claims other than the differences that are discussed below.

With respect to the limitations of claim 3, Owen does not specifically teach that the container is formed of steel. However, he teaches that the container may be made of a material other than aluminum (see col. 5, lines 55-57).

It would have been obvious to one of ordinary skill in the art to form the container from a material such as steel because Owens teaches that the container is formed from a metal material and that the material may be a material other than aluminum.

With respect to the limitations of claims 9 and 10, Owens does not specifically teach that the soot removal agent is coated on a substrate. However, he teaches that the aluminum container may function as part of the catalyst and this teaching suggests the substrate and coating.

With respect to the limitations of claims 12 and 13, Owens teaches that the catalyst comprises bullets or pellets, i.e., ingots. He teaches a plurality of Applicant's claimed single body ingot, pellet or bullet; however, it is well settled that a duplication of parts, such as the ingot or pellets, renders obvious a single ingot or pellet.

With respect to claims 14-16, Owens teaches that the container contains caps on both ends of the container and that these caps comprise a head with an opening formed there through and a cylindrical cap wall with threads to be screwed to the threads of the cylindrical member. This teaching suggests the at least one end of the container being open, partially closed and partially closed by an inwardly directed flange.

With respect to claim 17 and the shape of the container, it is well settled that the configuration of a container is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container is significant.

***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the present invention is for cleaning a flue or a chimney whereas Owen uses his container to reduce harmful emission gases.

It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The claims are directed to an enclosed container formed of noncombustible heat resistant material wherein the interior contains a soot removal agent. Owen has set forth such a container. The newly added functional language set forth in the claims does not distinguish over Owen. If a prior art structure is capable of performing the intended use

as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

8. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest that the opening is closed by a closure formed of a material which will be consumed slowly upon the flue cleaner being placed in a fire; that the soot removal agent is encased within the enclosed container within a settable composition (sawdust and a binding agent) which will harden once being introduced into the enclosed container.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cephia D. Toomer/  
Primary Examiner  
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